

### REMARKS

The claims now before the examiner are 1-3, 5-8 and 10-14.

#### **The amendments to the claims**

Support for the R-isomers, as now used in the claims is found, e.g., at col. 2, lines 1-44 of the parent patent.

New claims 13 and 14 combine the features of R-isomers of imidazolines and imidazoline resistance/tolerance. Support for these claims is found, e.g., at col. 3, lines 56-62 of the parent patent.

#### **The double patenting rejection of the obviousness type**

The Terminal Disclaimer filed herewith obviates this rejection.

#### **The rejections over prior art**

The previous claims were rejected as follows:

1) Claims 8 and 10, under 35 USC 102 (a), (b) and (e) over any one of Martin, Morgan or Kimler (documents A, B and C respectively, of the PTO-892).

2) Claims 1-3, 5-8 and 10-12 (all claims), under 35 USC 103(a), over the combined teachings of Morgan, Martin or Kimler in combination with Klingman (document U) and Anderson (document V).

Insofar as rejection 1) is concerned, applicants invention, as now claimed, is not

anticipated by any one of the three references because applicants' claims are now limited to the **R**-isomers of the imidazolinones. As is pointed out at MPEP 2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)

None of the three references meet this standard.

Regarding rejections 2), nowhere in the combination of references is a reasonable suggestion, teaching, or motivation to utilize the **R**-isomers of the imidazolinones in the claimed composition. Accordingly, the rejection does not make out the **necessary** prima facie case for obviousness. See, inter alia, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988) ("Something in the prior art as a whole must suggest the desirability and thus the obviousness, of making the combination.")

It is also of significance to note that a general disclosure of Plant Tolerance of imazaquin or "imidazolinone herbicides" is given in W. P. Anderson, *Weed Science*, 1996, on page 201 (the Anderson reference is cited by the Examiner).

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Serial No. 10/692,817

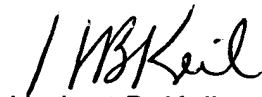
**Conclusion**

For the foregoing reasons, allowance is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'H B Keil', written in a cursive style.

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